

Serial No. 10/801,307.

**IN THE DRAWINGS**

**Amendments To Drawing Figures**

Figs. 11A-11C have been amended to schematically illustrate the two valve seats as requested in the Office Action. New drawing sheets are attached. The drawings are a schematic depiction of what is described in the specification. No new matter is added.

## **REMARKS**

### **Claim Status**

Claims 1-20 remain in this application.

### **Objections to the Drawings**

A Request for Approval to Make Drawing Changes is attached as requested by the examiner, along with 15 sheets replacement drawings. These Replacement Drawings address the objections noted in the Notice of Draftsperson's Patent Drawing Review (PTO-948 form) that was attached to the Office Action mailed July 10, 2006.

The drawings continue to be objected to by the Examiner. Examiner now states that not only the first position, second position and default neutral positions, but also the two valve seats, must be shown in the drawings or cancelled from the claims.

Responsive to this objection, applicants hereby submit corrected drawings, which now show schematically show these features.

The Examiner erroneously alleges that "a schematic drawing cannot represent the open and closed positions of the valve when only details of relative positions of the internal parts and features of the valve can clearly show the respective positions."

37 CFR 1.83(a) clearly states that features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, *should be* illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In this regard, it is respectfully submitted that one of ordinary skill in the art would readily understand the three possible positions of the valve that is described and claimed herein, for example, by following the instructions in the specification regarding the construction of such a valve. For further details, see, e.g., the discussion to follow regarding 35 USC § 112, first paragraph.

**Rejection under 35 USC § 112, first paragraph**

Claims 2, 4, 11 and 19 have been rejected under the first paragraph of 35 U.S.C. 112 as lacking enablement in the specification as filed. This rejection is respectfully traversed.

It is respectfully requested that the remarks presented in applicant's response filed October 10, 2006, be herein incorporated by reference. The following remarks are presented for emphasis and further explication in view of the arguments in the final rejection.

The following is well established PTO procedure, based on the statute and precedent:

A specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of section 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

MPEP 2164.04 (emphasis added) (citing *In re Marzocchi*, 439 F.2d 220, 223, 169 U.S.P.Q. 367, 369 (CCPA 1971)).

Because of the relatively mechanical nature of the devices claimed, it is difficult to comprehend the examiner's refusal to take the teachings in the specification as being in compliance with the enabling requirement of section 112.

Applicant's specification asserts that the present invention provides methods and apparatuses utilizing "a double pneumatic acting valve" that has "a default neutral state so that the valve seats remain open when not in use, thereby preventing seizure of the valve seats in the open or closed position." Paragraph [0004]. That is a statement of an improvement of the present invention over the prior art. As noted in paragraph [0033], "when the spray coat machine is not in use, neither valve seat is held closed, which eliminates the possibility [of] the valve seat being glued shut."

In the DETAILED DESCRIPTION of the specification, an exemplary simple method of manufacture of such a device, based on an existing three-way valve, is set forth with reference to illustrative drawings of both the prior art and the here-claimed invention. See paragraphs [0032] to [0033] and [0040] to [0043]. It is not clear what

more the examiner considers necessary to enable one of ordinary skill to practice the invention claimed in claims 2, 4, 11 and 19.

The examiner has put forth no reason to doubt that the instructions in the specification will yield a valve in having default neutral state in which all valve seats of the three-way valve remain open when a supply pressure operating the valve is removed. In the absence of record evidence or prior art, the examiner has not satisfied the burden of providing such reason to doubt the objective truth of the statements in applicant's specification.

Reconsideration and withdrawal of the rejection under 35 U.S.C. 112, first paragraph are therefore requested.

**B. 35 U.S.C. 103(a) – Kintner and acknowledged state of the art – Claims 2, 4, 5, 7 and 10-13**

Claims 2, 4, 5, 7 and 10-13 have been rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's "admitted prior art" (Figure 1) in view of Kintner US 3,426,799. This rejection is respectfully traversed.

It is respectfully requested that the remarks presented in applicant's response filed October 10, 2006, be herein incorporated by reference, including applicant's comments regarding the "default neutral state." The following remarks are presented for emphasis and further explication in view of the arguments in the final rejection.

All presently pending claims require a dual pneumatic actuated three-way valve comprising two valve seats. Kintner, on the other hand, does not teach or suggest valves of this type, but rather teaches piston-operated valves. In fact, Kintner dismisses valves having seats, diaphragms, etc., as unreliable. Col. 1, lines 12-15.

Figure 1 illustrates a stent spraying apparatus. The specific construction of the valve 70 is not prior art. As is clear from paragraph [0024], the dual pneumatic actuated three way valve 70 is an embodiment of the here-claimed invention. Therefore, Figure 1 is not "admitted prior art."

Figure 3 of Kintner is referred to by the examiner. However, in describing the disclosure of Kintner (paragraph bridging pages 5 and 6 of the Final action), the examiner

has blended features of Figures 2 and 3, with no explanation, and apparently inappropriately. Figure 2 describes an “on-off” valve and is a two-way valve. See col. 1, lines 35-40. Figure 3 does describe a three way valve referred to as “a diversion type valve.” The valve in Figure 3, however, does not have the liquid or gas inlets 6 and 8 of Figure 2 referred to by the examiner.

The rejection is further confusing because of the examiner’s reference to two valve seats (13, 14 and 15). In addition to the conflict in the number of items referred to, the fact is that those elements of Figure 2 (corresponding to elements 31, 32 and 33 in Figure 3) do not denote “seats” at all, but rather denote “O-rings” or “sealing rings” which form “seals” with the inner surface of the valve body. See column 1, line 69, and column 2, lines 3-5. The fact that there is no reference to valve “seats” is consistent with the disclosure in Kintner that their use is obviated by the disclosed valves. Column 1, lines 20-24. To whatever extent “open” and “closed” may have any meaning in the context of Figure 3 of Kintner, the O-rings would appear to be “closed” since they are compressed between the pistons and the cylinder wall.

The examiner has yet to explain how one of ordinary skill in the art would utilize any of the valves of Kintner (which are unlike those presently claimed) in a system such as that illustrated in applicant’s Figure 1 with any reasonable expectation of success. See MPEP 2143.02 and the cases cited therein. Furthermore, in view of the foregoing comments concerning the nature of the valves disclosed by Kintner, it is clear that, if one were to use a valve of Kintner in the relevant system, applicant’s claimed invention would not result.

In view of the above remarks, it is respectfully requested that this rejection be reconsidered and withdrawn.

**C. 35 U.S.C. 103(a) –Liston and Kintner**

Claims 1-7 and 10-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Liston US 3,817,425 in view of Kintner. This rejection is respectfully traversed.

It is respectfully requested that the remarks presented in applicant’s response filed October 10, 2006, be herein incorporated by reference. The following remarks are

presented for emphasis and further explication in view of the arguments in the final rejection.

The Office Action alleges that Liston is deficient in the same way as the “admitted prior art” in section B above is deficient (e.g., it doesn’t disclose a valve that is a pneumatically actuated three-way valve with no spring return mechanism and two valve seats). Thus, the foregoing remarks in section B are applicable to this rejection as well.

Moreover, it is noted that Figure 3 of Kintner does not show any “air pressure diaphragms” as required by instant claims 1, 3, 6 and 14-20, and there would be no evident use for them. Indeed, even in conjunction with Figure 2 of Kintner, there is no reference to air pressure diaphragms.

With respect to claim 7, it appears that the examiner has not indicated where in Liston it is disclosed that tubes **275** and **298** have different diameters. The discussion of Figure 9, at column 4, line 51, to column 5, line 20, appears silent in that regard. In the event that applicant has overlooked the relevant disclosure, the fundamental defects in the references would remain.

In light of the foregoing remarks, it is respectfully requested that this rejection be reconsidered and withdrawn

**D. 35 U.S.C. 103(a) – Kintner and acknowledged state of the art – Claims 1, 3 and 14-20**

Claims 1, 3 and 14-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over applicant’s “admitted prior art” (Figures 1-8) in view of Kintner US 3,426,799. This rejection is respectfully traversed.

It is respectfully requested that the remarks presented in applicant’s response filed October 10, 2006, be herein incorporated by reference. The following remarks are presented for emphasis and further explication in view of the arguments in the final rejection.

This rejection is similar to the rejection of claims 2, 4, 5, 7 and 10-13 over the same prior art (Part B) and by and large the same comments apply. Moreover, as indicated in Part C above, Kintner does not show any “air pressure diaphragms” as required by claims 1, 3 and 14-20.

In addition, a specific additional factual error stated in this rejection will be addressed here.

Figures 4 and 5 of Kintner apply to two-way “on-off” valves. No equivalence is disclosed for the “diversion type valve” of Figure 3, which is a three way valve. In this regard, it is noted the “cock valves” 41 in Figures 4 and 5 have three-way character, rather than the valves themselves.

In view of the above remarks, it is respectfully requested that this rejection be reconsidered and withdrawn.

**35 U.S.C. 103(a) – Admitted prior art, Liston and Chemline Plastics**

Claims 8 and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over “admitted prior art,” Liston and Chemline Plastics. This rejection is respectfully traversed based on the remarks presented in the response to the previous office action.

The examiner has not responded to applicant’s arguments against the propriety of this rejection or added any comments over and above those set forth in the previous Office action. Thus applicant need not address any further remarks to this rejection over and above those incorporated by reference.

**Conclusion**

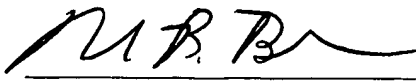
In light of the foregoing amendments and remarks it is respectfully considered that the rejections of record have been obviated, and allowance of this application is respectfully requested.

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Fees

The Examiner is authorized to charge any fees that may be due to the undersigned attorney's PTO Deposit Account #50-1047.

Respectfully submitted,

By: 

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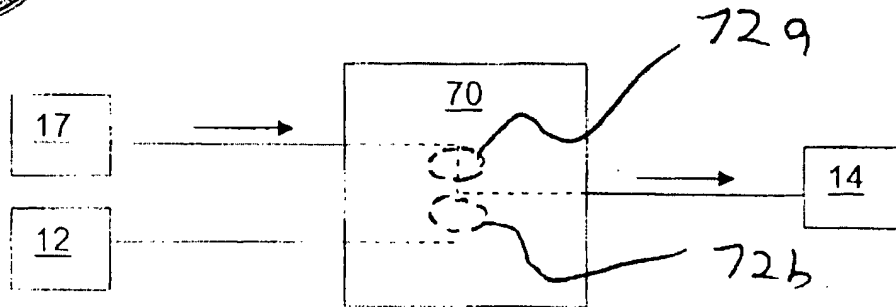
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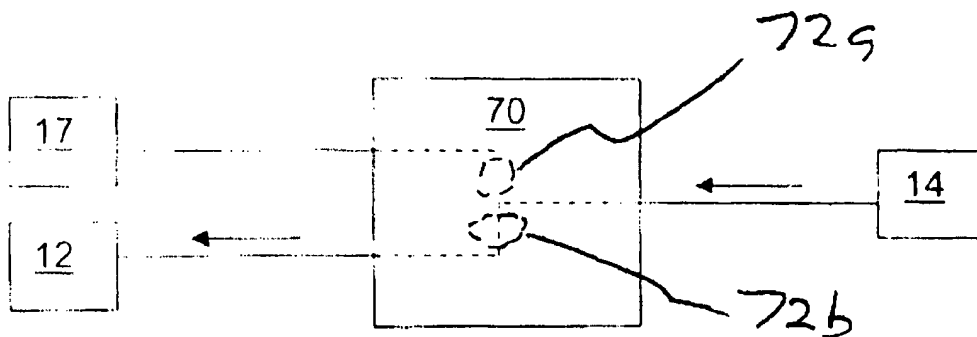




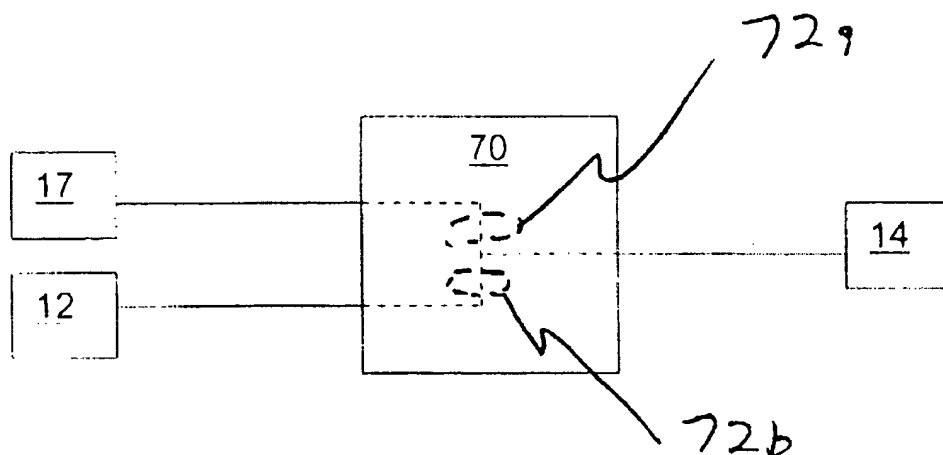
**FIG 17A**



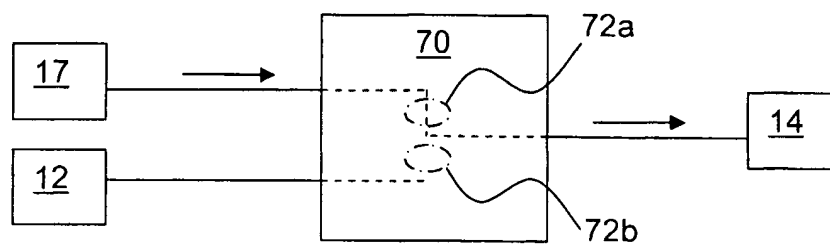
**FIG 17B**



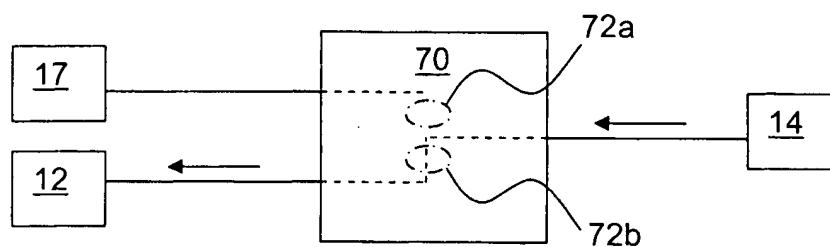
**FIG 17C**



**FIG 17A**



**FIG 17B**



**FIG 17C**

